

10-22-02



Docket No: 1232-4579

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Hiroshi KAIBARA
Serial No. : 09/415,668 Group Art Unit : 2622
Filed : October 12, 1999 Examiner: M.A.V. Nguyen
For : **IMAGE COMMUNICATION METHOD, APPARATUS, AND SYSTEM**

Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

OCT 22 2002

Technology Center 2600

The Office Action mailed on September 25, 2002 provides that restriction to one of the following inventions is required under 35 U.S.C. §121:

Group I “(Claims 1-11, 24-34 and 50) drawn to an image communication method and apparatus for outputting transmitted images and a transmission order of the images on the basis of information held in a list, classified in class 358, subclass 438.”

Group II “(Claims 12-16, 35-39 and 51) drawn to an image communication apparatus and method capable of generating a list holding information representing the received images and information representing a reception order of the images, classified in class 358, subclass 439.”

Group III “(Claims 17-23, 43-49 and 52) drawn to an image communication apparatus and method capable of generating three different list holding information, classified in class 358, subclass 404.”

Group IV “(Claims 40-42) drawn to an image communication system having a plurality of image communication apparatuses for transmitting and receiving image data, classified in class 358, subclass 442.”

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Applicant provisionally elects for prosecution the invention of Group I (Claims 1-11, 24-34 and 50). Applicant believes that the restriction requirement is improper and therefore makes the above election with traverse.

Applicant respectfully submits that for a restriction requirement to be proper, MPEP §803, is clear that "there are two criteria for restriction between patentably distinct inventions" as follows:

- “(1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is not required” (emphasis added)

Applicant respectfully submits that: all groups of restricted claims are properly presented in the same application; undue diverse searching would not be required; and all claims should be examined together. Accordingly, examination of the claims of Groups II-IV, in addition to the claims of Group I, would place no additional "serious" burden on the Examiner as examination of the claims of Groups II-IV would not require undue diverse searching beyond that which would be necessary for examination of the claims of Group I.

Applicant respectfully submits that the claims of Groups II-IV should be examined on the merits as well.

For the foregoing reasons, it is respectfully submitted that the restriction requirement should be withdrawn and an action on the merits of all the claims is respectfully requested.

AUTHORIZATION

No fees are believed necessary in connection with this response. While

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Applicants believe no extension of time to be necessary for this Response, should an extension of time be required, such extension is petitioned. The Commissioner is authorized to charge any fees or credit any overpayments which may be required for this paper to Deposit Account Number 13-4500, Order No. 1232-4579. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

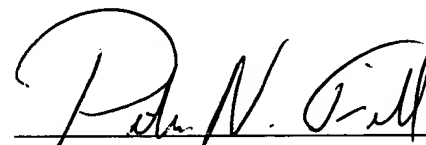
In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 1232-4579. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: October 9, 2002

By: _____



Peter N. Fill

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CERTIFICATE OF MAILING (37 C.F.R. §1.8(a))

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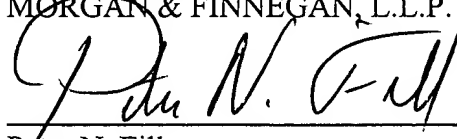
Sir:

I hereby certify that the attached:

1. Response to Restriction Requirement and
2. Return-Receipt Post Card

along with any paper(s) referred to as being attached or enclosed and this Certificate of Mailing are being deposited with the United States Postal Service on date shown below with sufficient postage as first-class mail in an envelope addressed to the: Commissioner for Patents, Washington, D.C., 20231.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

By: 
Peter N. Fill
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Dated: October 9, 2002

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